

## REMARKS

Reconsideration of this application as amended is respectfully requested. An RCE accompanies this Amendment. In this response, claims 1 and 5 are amended and claim 3 is canceled. No new matter has been added.

### Claim Rejections – 35 U.S.C. § 103

Claim 1 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Japanese Patent Application No. 10165203 to Shimizu (“Shimizu”) in view of U.S. Patent No. 5,758,435 to Miyata (“Miyata”) and U.S. Patent No. 6,502,331 to Hines (“Hines”).

Claim 1, as amended, recites:

1. Health shoes comprising cumulate layers including a layer of cup in sole layer, middle sole layer, high elasticity sponge layer, and cushion layer; a plurality of round-shaped seat holes formed in a thickness direction of a bottom rubber sole formed at a lower part of said cushion layer; and **metal balls** to be fixed in the plurality of round-shaped seat holes, **wherein diameters of the plurality of round-shaped seat holes are gradually reduced from heel part to front part of the bottom rubber sole, and the metal balls fixed in the plurality of round-shaped seat holes are formed to be same sizes as the diameters of the plurality of round-shaped seat holes,** wherein more than two refraction line holes are formed in a width direction at the front of the bottom rubber sole.

(Emphasis added).

Shimizu discloses a shoe with rectangular-shaped weights inserted in the bottom of the shoe. (Shimizu, Figures 1, 5, and 7). Miyata discloses a training shoe with weights uniformly buried snugly in the weight chambers over the entire area of the sole. (Miyata, Abstract; col. 1, lines 55-56; col. 2, lines 63-66). Hines discloses an athletic training shoe insert including particles of heavy material mixed with a flexible porous material and molded into an insole form to fit within a shoe. (Hines, Abstract).

As the Office Action acknowledges, Shimizu does not disclose round-shaped weight bodies. (Office Action, 11/24/09, page 2). However, the Office Action states that Hines discloses weights with different shapes, including spheres. Thus, “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the weights in the sole of Shimizu in the shape of a ball, as this would be a simple substitution of one shape for another, with the predictable result of providing greater flexibility in the transverse direction.” (Office Action, 11/24/09, pages 2-3)(Emphasis added). Applicant respectfully disagrees with the Office Action’s characterization of the cited references.

It is respectfully submitted that one of ordinary skill in the art would not have reason nor be motivated to combine Shimizu with Hines because the purported combination would result in substantial redesign of Shimizu. Shimizu discloses rectangular shaped weights that need to be varied from the heel to toe. (Shimizu, Figure 1 and Figure 5). Accordingly, Shimizu’s design requires rectangular shaped seat holes to accommodate those rectangular shaped weights. On the other hand, because the weights in Hines are molded into an insole form to fit within a shoe, Hines does not suggest the size and placement of the weight particles. If Shimizu and Hines were combined as suggested by the Office Action, the sphere shaped weights in Hines would not be able to fit into the rectangular shaped seat holes in Shimizu. As a result, all of the seat holes in Shimizu need to be redesigned and redistributed in order to accommodate the sphere shaped weights and to achieve the weight variation desired by Shimizu, which is not “a simple substitution of one shape for another,” as alleged by the Office Action.

It is further respectfully submitted that one of ordinary skill in the art would not have reason nor be motivated to combine Shimizu with Hines because the purported combination would render Shimizu unsatisfactory for the intended purpose. Shimizu discloses square

shaped seat holes in Figure 7, which might be able to accommodate the sphere shaped weights. However, the square shaped seat holes are uniform in size, which demands the sphere shaped weights to be uniform in size as well. Thus the purported combination of Shimizu and Hines would result in the weights to be substantially evenly distributed, which renders Shimizu unsatisfactory for the intended purpose of weight balance change.

It is further respectfully submitted that one of ordinary skill in the art would not have reason nor be motivated to combine Shimizu with Miyata and Hines. Motivation to combine or modify the prior art is lacking when the prior art teaches away from the claimed combination. Applicant respectfully submits that Miyata teaches away from the combination with Shimizu because Miyata is designed to promote the balance of shoes by uniformly distributing metallic grains throughout the entire area of the sole. (Miyata, col. 1, lines 55-60). The Office Action states that Miyata does not teach the uniform distribution of the weight and “Miyata merely teaches that it is desirable to provide insole, midsole, and cushioning layers above a sole layer.” (Office Action, 11/24/09, page 4). Applicant respectfully disagrees and submits that Miyata teaches that “weights are distributed uniformly over the entire area of the sole ....” and “[t]he weights 8 are buried snugly and uniformly in the weight chambers 6 ....” (Miyata, col. 1, lines 55-56; col. 2, lines 63-64)(Emphasis added). The uniform seat holes, as shown in Figure 1, Figure 3, and Figures 4A-4C, demonstrate that the weights in Miyata are uniformly distributed. In contrast, Shimizu’s design requires the distribution of the weights to be varied throughout the sole. (Shimizu, Figures 1 and 5). Because Miyata teaches away from Shimizu, one of ordinary skill in the art would not have reason nor be motivated to combine Shimizu with Miyata.

Claim 3 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimizu, Miyata, and Hines, further in view of US Patent No. 7,100,307 to Burke (“Burke”). Applicant does not admit that Burke is prior art and reserves the right to swear behind Burke.

Claim 3 has been canceled. Nevertheless, the limitation of claim 3 has been added to the amended claim 1. Applicant respectfully disagrees and submits that there is no reasonable expectation of success if Shimizu were combined with Burke. As shown in Figure 1 and Figure 7, Shimizu teaches a very narrow partition 5 that divides any two rectangular shaped seat holes. Because the partition 5 is so narrow, it is almost impossible to form any refraction line holes on such a narrow partition. Furthermore, Shimizu also shows in Figure 5 that there is no partition at all in the front of the shoe, which made it impossible to form any refraction line holes in the front portion of the sole. Thus, one of ordinary skill in the art would not have reason nor be motivated to combine Shimizu, Miyata, Hines, and Burke. It would be impermissible hindsight based on applicant’s own disclosure to combine the cited references.

Even if Shimizu, Miyata, Hines, and Burke were combined, the combination of the cited references would lack at least one feature of claim 1. Shimizu discloses in Figure 1 and Figure 5 that the sizes of the rectangular shaped seat holes vary according to the size and shape of the sole. Miyata discloses uniformly distributed seat holes, and Hines does not disclose the distribution and placement of the weights at all because Hines teaches to mold the weights into the sole. Accordingly, the combination of the cited references does not teach or suggest the “diameters of the plurality of round-shaped seat holes are gradually reduced from heel part to front part of the bottom rubber sole, and the metal balls fixed in the plurality of round-shaped seat holes are formed to be same sizes as the diameters of the plurality of round-shaped seat holes,” as recited in claim 1.

The claimed features in claim 1 make it easy to keep balance, and the weight bodies rarely come off, even if the shoes are twisted to the left, right, front or back with the round-shaped metallic grains. In addition, claim 1 has a superior effect such that the user may easily take his feet off the ground and feel less fatigue because the heel part of the shoe, which is heavier than the front part of the shoe, contacts with the ground first.

At least for the reasons stated above, applicant respectfully submits that claim 1 is patentable over the combination of the cited references.

Accordingly, applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. § 103(a) be withdrawn.

Claim 5 has been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shimizu, Miyata, and Hines, as applied to claim 1, and further in view of Burke. As stated above, applicant does not admit that Burke is prior art and reserves the right to swear behind Burke.

Similar to the reasons stated with respect to claim 1, applicant respectfully submits that claim 5 is patentable over the combination of the cited references because one of ordinary skill in the art would not have reason nor be motivated to combine the cited references. As discussed above with respect to claim 1, the purported combination between Shimizu and Hines is not “a simple substitution of one shape of another.” Rather, it would result in substantial redesign of Shimizu. Furthermore, the purported combination of Shimizu and Hines would render Shimizu unsatisfactory for the intended purpose. In addition, Miyata teaches away from Shimizu because Miyata discloses that the weights need to be uniformly distributed. Finally, one of ordinary skill in the art would not have reason nor be motivated to combine Shimizu and Burke because Shimizu’s design made it almost

impossible to form any refraction lines holes on the front portion of the sole. It would be impermissible hindsight based on applicant's own disclosure to combine the cited references.

Accordingly, applicant respectfully requests that the rejection of claim 5 under 35 U.S.C. § 103(a) be withdrawn.

## CONCLUSION

In conclusion, applicant respectfully submits that in view of the arguments and amendment set forth herein, the applicable objections and rejections have been overcome.

Applicant reserves all rights under the doctrine of equivalents.

Pursuant to 37 C.F.R. 1.136(a)(3), applicant hereby requests and authorizes the U.S. Patent and Trademark Office to (1) treat any concurrent or future reply that requires a petition for extension of time as incorporating a petition for extension of time for the appropriate length of time and (2) charge all required fees, including extension of time fees and fees under 37 C.F.R. 1.16 and 1.17, to Deposit Account No. 02-2666.

Respectfully submitted,

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